

Serial No. 0 986,815
Attorney Docket No. 250-004

REMARKS

Claims 21-34 are pending in the application. Applicant has amended claims 21 and 32, cancelled claim 34, and added new claims 35 and 36. Neither the amended claims nor the new claims contain new matter.

1. The Rejection under 35 U.S.C. § 112, first paragraph

Claims 21-34 stand rejected under the first paragraph of 35 U.S.C. § 112 as allegedly containing subject matter not described in the specification so as to enable one skilled in the art to make and/or use the invention.

Independent claims 21 and 32, as amended, define element (B) as "*an amine solidifying system present in insufficient quantities to cause gelation after the amino hydrogen atoms are consumed by epoxy groups, under the reaction conditions chosen for (A) and (B)*" and further state that "*the reaction product of (A) and (B) has melting point stability of at least six months at normal workshop temperatures*". Support for these limitations is found in the specification at page 8, second paragraph and in original claim 1.

The Examiner relies upon "page 4, fifth paragraph, lines 2-3" to assert that independent claims 21 and 32 would be enabled only if element (B) contained the additional requirement that the reaction of elements (A) and (B) "yields a product with a Kofler Heat Bank melting point of less than 55°C." However, in selecting this particular passage, the Examiner may have overlooked the introductory clause at page 4, fourth paragraph, lines 5-6, which makes clear that the ingredients that follow are exemplary only ("For example the method of this invention could be performed using the following classes of ingredients: ..."). As demonstrated by the passages on page 3 (third and fourth paragraphs) and on page 8 (second paragraph), the Kofler Heat Bank limitation describes only one embodiment of the invention pertaining to element (B).

Applicant has adopted the Examiner's suggestion to amend the claims to state that element (C), the latent hardener, "*remains substantially unreacted under the condition of*

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reaction for (A) and (B)". Applicant has added the same limitation to element (E) (support for which appears in original claim 16).

The Examiner's final point regarding the complete reaction of (A) and (B) at room temperature has been obviated by eliminating that limitation from independent claims 21 and 32. The limitation was not present in original claims 1 and 16, and the specification states that the "reaction between (A) and (B) may be carried out at any suitable temperature and condition provided that neither it, nor the exothermic heat generated from it causes (C) or (E) to substantially react while it is taking place" (page 5, lines 3-5).

Applicant respectfully submits that the present claims are enabled by the specification and requests that the rejection be withdrawn.

2. The Rejection under 35 U.S.C. § 112, second paragraph

Claims 21-34 stand rejected under the second paragraph of 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter Applicant regards as the invention.

The Examiner rejects the phrase "*reaction between (A) and (B) does not cause (C) or (E) to substantially react*" in independent claims 21 and 32. Applicant has obviated this ground for rejection by amending the claims to eliminate this phrase.

The Examiner rejects Claim 26 for allegedly failing to denote the epoxy groups. Applicant has obviated this ground for rejection by amending claim 26 along the lines suggested by the Examiner.

The Examiner rejects the word "*mainly*" in claim 28. Applicants have obviated this ground for rejection by amending claim 28 to recite the customary term "comprising".

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The Examiner rejects claim 30 for implementing improper Markush language. Applicant has obviated this ground for rejection by amending claim 30 to recite conventional Markush language.

Applicant respectfully submits that the amended claims satisfy 35 U.S.C. 112, second paragraph, and accordingly, requests that the rejection be withdrawn.

3. The Rejection under the Judicially Created Doctrine of Double Patenting

Claims 21-34 stand rejected under the judicially created doctrine of double patenting over claims 1-14 of White (U.S. Patent No. 6,346,573). Applicant has obviated this rejection by filing a terminal disclaimer.

Applicant also submits herewith a Supplemental Information Disclosure Statement.

Applicant respectfully requests that the Examiner consider the references cited therein.

Finally, Applicant notes that the Examiner did not check any of the boxes under "Priority under 35 U.S.C. §§ 119 and 120" on the March 31, 2003 Office Action Summary Page. Applicant wishes to point out that this application is a continuation of 09/077,049 filed May 18, 1998 (as the amended specification now states pursuant to Applicant's November 13, 2001 Preliminary Amendment), which is a § 371 national stage of PCT/GB96/02822, which claims priority to United Kingdom application 9523649.3 filed November 18, 1995. If appropriate to do so, Applicant requests that the Examiner check the pertinent boxes in the next Official Communication.

Applicant believes that the present application is now in condition for allowance. Favorable consideration of the application as amended is respectfully requested.

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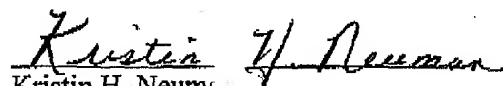
The Commissioner is authorized to charge any fee due, or credit any overcharge as a result of this Amendment and Response to Deposit Account No. 16-2500.

Respectfully submitted,

Proskauer Rose LLP

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By


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